

REMARKS

This responds to the Office Action dated November 16, 2007.

Claims 1 and 3 are amended. Claim 1 has been amended to incorporate the limitations of claim 2. Claim 3 has been amended to incorporate the limitations of claims 6 and 10. Both claims 1 and 3 have further been amended to clarify the limitations of the amended claims and to correct antecedent basis typos. The Applicants respectively submit that the amendments to claims 2 and 3 are not meant to add to or subtract from any of the limitations in claims 1, 2, 3, 6, and 10.

Claims 2, 4-6, 10 and 12 are canceled. Claim 13 is added. Claims 1, 3, 7-9, 11 and 13 are pending in this application.

§101 Rejection of the Claims

Claim 12 was rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claim 12 has been canceled rendering the rejection moot.

§102 Rejection of the Claims

Claim 1 was rejected under 35 U.S.C. § 102(b) for anticipation by Otsuka (U.S. Patent Application Publication No. 2001/0025269).

Applicable law

Anticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

As noted above, claim 1 has been amended. Amended claim 1 includes features recited in original claim 2.

The features of amended claim 1 include the following:

*recording user profile information for the user; and
crediting a bill for the certain amount with a sum, upon receipt of
the recorded user profile information together with the registered usage
information.*

Since claim 2 was rejected under § 103, the rejection of amended claim 1 is treated in the § 103 rejection of claim 2 in this paper.

§103 Rejection of the Claims

Claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Otsuka (U.S. Patent Application Publication No. 2001/0025269) in view of Ginter (U.S. Patent No. 7,133,845).

Applicable law

In the recent decision of the Supreme Court on *KSR Int'l Co. v. Teleflex Inc.*¹, the analysis of obviousness previously set forth in *Graham v. John Deere Co. of Kansas City*², was reaffirmed. The Court in *Graham* set out an objective analysis for applying §103 as follows:

“Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined.”³

¹ 127 S.Ct. 1727, 82 USPQ.2d 1385 (2007).

² 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966).

³ The Court in *KSR v. Teleflex*, at page 1730, quoted the analysis of *Graham* from page 18.

When claim elements are found in more than one prior art reference, the fact finder must determine “whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims.” *In re Kahn*⁴. In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co. of Kansas City*⁵. Further, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*⁶. “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*⁷. Office personnel must rely on the applicant’s disclosure to properly determine the meaning of the claims. *Markman v. Westview Instruments*⁸.

The Office Action concedes that the features of amended claim 1, set forth above are missing from Otsuka. The Office Action alleges that the same features can be found in Ginter and that the remaining features of claim 1 (see amended claim 1) can be found in Otsuka. The Applicants traverse an anticipated § 103 rejection of amended claim 1 that is based on the combination of Otsuka and Ginter.

The cited portion of Ginter recites the following:

*A financial clearinghouse normally receives at its location
securely delivered content usage information, and user requests (such as
requests for further credit, electronic currency, and/or higher credit limit).
**Reporting of usage information and user requests can be used for
supporting electronic currency, billing, payment and credit related
activities, and/or user profile analysis and/or broader market survey
analysis and/or market survey analysis...***

(Ginter, column 36, lines 27-35)

⁴ 441 F.3d 977, 988, 78 USPQ2d 1329, 1337 (Fed. Cir. 2006).

⁵ 383 U.S. 1 at 467.

⁶ 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

⁷ 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

⁸ 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir.) (*en banc*), *aff’d*, U.S., 116 S. Ct. 1384 (1996).

The Applicants have reviewed the cited portions of Ginter and respectfully submit that the features of claim 1 above are not taught or suggested by Ginter. Rather, the Applicants believe that the Office Action's conclusion is based on a misunderstanding or confusion with respect to the cited portion of Ginter.

The Applicants acknowledge that Ginter includes the words or phrases, "usage information," "credit" and "user profile." But the Applicants respectfully assert for the reasons described below, that neither Ginter, Otsuka or their combination teach or suggest all the limitations of claim 1, as required under the patent law.

Taking "user profile" for example: Claim 1 requires "**recording** user profile information" while Ginter describes a "user profile **analysis**." "User profile" of claim 1 is clearly acted upon differently than the "user profile" in Ginter, where the **user profile** appears to be **subjected to analysis**. Although some of the same words are used, "recording a user profile" is hardly taught or suggested by a "user profile analysis." For that reason alone, Ginter does not teach or suggest what is required by claim 1.

Significantly, the context of use of the word "**credit**" in Ginter gives it a different meaning than that of "**crediting**" in claim 1. To illustrate the context, column 36, line 30 of Ginter includes references to "requests for further credit, electronic currency, and/or higher credit limit." Unlike the features of claim 1, Ginter uses "credit" in the context of creating debt. Thus, when Ginter recites, "[r]eporting of usage information and user requests can be used for supporting electronic currency, billing, payment and **credit related activities**," the contextual evidence indicates that "credit related activities" in fact are associated with creating debt. As such, Ginter does not teach or suggest "crediting a bill" **much less** "crediting a bill for the certain amount with a sum, upon receipt of the recorded user profile information together with the registered usage information" as required by claim 1.

Further, the word "credit" as presented in Ginter does not teach or suggest "crediting a bill...with a sum" at least because in Ginter, "credit" is used as noun (e.g., a credit account, credit card or a line of credit, etc.) and not used as a verb (e.g., crediting a bill).

Still further, the Office Action does not point out and the Applicants cannot find where Ginter teaches or suggests “receipt of the recorded user profile information together with the **registered usage information.**”

In sum, neither Ginter, Otsuka nor their combination can teach or suggest the features of claim 1. Thus, the Applicants respectfully submit that claim 1 overcomes a § 103 rejection based on the combination of Otsuka and Ginter as presented in the Office Action’s rejection of claim 2 under § 103.

Claims 3-7 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Otsuka (U.S. Patent Application Publication No. 2001/0025269) in view of Levy (U.S. Patent Application Publication No. 2002/0052885).

As stated above claim 3 is has been amended to include the limitations of claim 6 and claim 10.

The limitations of amended claim 3 include the following:

*wherein the device is arranged to **inhibit sharing of the multimedia object** in response to the reporting means failing to transmit the **registered usage information** to the third party.*

The Office Action states that the above features are taught or suggested in WO/00/72119 herein cited as U.S. Patent 7,073,197 to Rabin et al. (hereinafter Rabin) . The general idea of Rabin can be summarized as follows:

*The invention provides a system[,] methods and apparatus for supervising **usage** of software on a user’s device and for a monitoring regime that prevents a device from employing any instance of software in a manner not authorized by the legitimate vendor or owner of the rights to that software.*

(Rabin column 3, lines 4-9)

The Office Action refers particularly to Rabin column 8, lines 58-63, which recites the following:

When a user device fails to perform a call-up procedure with the guardian center before the end of a maximum allowed interval since the last call-up procedure, the user device is disabled for a period of time or usage of certain instances of software is denied for a period of time.

The Applicants respectfully traverse the Office Action's § 103 rejection because as discussed below, Rabin at least does not teach or suggest "the device is arranged to inhibit **sharing**...in response to...failing to transmit the **registered usage information**..." Again, a proper rejection under § 103 would require that **all the claim limitations** above were taught or suggested by Rabin.

Rabin does not teach or suggest **inhibiting sharing** because Rabin's use of the word "usage" does not include the concept of "sharing." The meaning given to the word usage by Rabin is as follows:

In general, software can be installed on, accessed by, or used on a user device, with each of these access modes referred to hereinafter as use or use of software. Thus for example, use of an instance of software which is an application program includes but is not limited to, installing that instance or reading it or copying it or executing it. And use of text includes, but is not limited to, installing the text on the device or reading the text by use of the device or copying portions of that text on or by use of the device.

(Column 3, lines 48-57)

Rabin does not contemplate the inhibition of "sharing" because with respect to activity on a user device, Rabin only contemplates controlling, installation of software on the user device,

access to software by the user device, or using the software on the user device. None of these uses include the idea of “sharing”

Further evidence that Rabin does not contemplate “sharing of the multimedia object” includes Rabin’s explanation of how software instances are distributed to user devices; it does not include sharing. Referring to FIG.1, Rabin recites “the [software] instances 111-114 may be downloaded from the software vendor(s) 101,” [a]lternatively, user devices 104 may be pre-equipped with the instances of software 111-114 that are pre-installed by a user device manufacturer,” “[a]s another alternative, users...may purchase the instances...on a user device readable medium...” (Rabin, column 38, lines 25-54). Notably, Rabin does not include sharing as a way for a user to obtain software.

It stands to reason from Rabin’s own disclosures - that the uses of software on a user device described by Rabin (e.g., installing software, reading software, copying software, executing software) **do not** teach or suggest “**sharing of the multimedia object**” as required by claim 3.

The Office Action apparently alleges that Rabin’s “fails to perform a call-up procedure” teaches or suggests “failing to transmit the registered usage information.” Rabin does not teach or suggest “failing to transmit the **registered usage information**.” As can be seen in block 372 of Rabin’s FIG. 12 reproduced below, unlike “registered usage information”, the “call-up procedure” only involves the transmission of “the tag table” and the “fingerprint table,” which clearly do not teach or suggest “registered usage information.” Rabin fails to describe the limitations that would be required to establish a rejection of claim 3 under § 103.

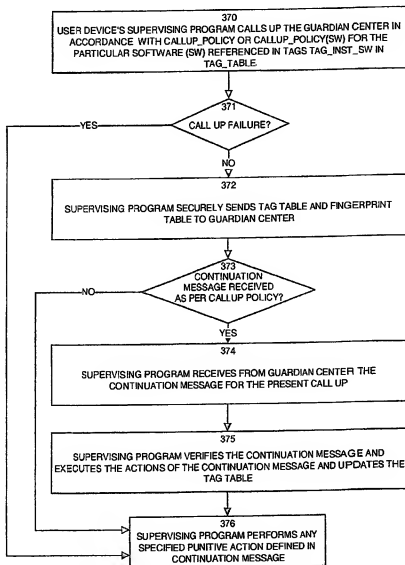


FIG. 12 CALL UP OF GUARDIAN CENTER FROM USER DEVICE

The Office Action does not direct the Applicants to where in Otsuka or Levy, the features missing from Rabin can be found. For the reasons explained above, the Applicants respectfully submit that neither Otsuka, Levy, Rabin nor any of their combinations teach or suggest what claim 3 requires. As such, that Applicants respectfully request the withdrawal of the Office Action's § 103 rejection.

The Office Action states that Rabin illustrates that the above features of claim 3 are well known in the art because Rabin discloses being arranged to inhibit sharing of the multimedia object in response to the reporting means failing to transmit the registered usage information to the third party. The Applicants traverse that assertion for the reasons explained above.

Based on a flawed conclusion regarding Rabin's coverage of claim 3 limitations, the Office Action further stated that it would have been obvious for one of ordinary skill in the art at the time of the invention to modify Otsuka to include the use of being arranged to inhibit sharing of the multimedia as taught by Rabin in order to improve file sharing devices.

Since Rabin does not teach those features, it appears that the Office Action is merely using inappropriate hindsight reconstruction based on the Applicant's own disclosure in an attempt to incorporate "the device is arranged to inhibit sharing of the multimedia object in response to the reporting means failing to transmit the registered usage information to the third party" into Otsuka. A factfinder should be aware of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742 (2007) (citing *Graham v. John Deere Co of Kansas City*, 383, U.S. 1, 36)).

Further, a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would **not** have been led to make the combination of Otsuka and Rabin to arrive at what is recited in the claims. Rabin may relate to controlling the overall usage of software but it is not concerned with "registered usage information" and "sharing" both of which present technical challenges having solutions that lie beyond what could have been learned from Rabin.

For at least the reasons explained above, the Applicant respectfully submits that amended claim 3 overcomes the Office Action's §103 rejections. Claims 3, 7-9 and 11 are dependent on claim 3 are overcome the rejections for at least the same reasons. The Applicants respectfully request that the Office allow the claims because they overcome the § 103 rejections.

Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Otsuka (U.S. Patent Application Publication No. 2001/0025269) and Levy (U.S. Patent Application Publication No. 2002/0052885), as applied to claim 3, and further in view of Ginter (U.S. Patent No. 7,133,845).

Claim 12 has been canceled rendering the rejection moot.

New Claim

Claim 13 is new. Claim 13 includes limitations of amended claim 1 and is believed to overcome the associated rejections for at least the same reasons as explained with respect to claim 1.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at 408-278-4052 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402
408-278-4052

Date 02/18/2008

By /Elena Dreszer/

Elena B. Dreszer
Reg. No. 55,128

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 18th, day of February 2008.

Dawn R. Shaw

/Dawn R. Shaw/

Name

Signature